



Case 51831AUSM1

Electronic / #7
6.20.02

RECEIVED

JUN 17 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Lau et al. :
Serial No. 09/838,785 : Group Art Unit 1642
Filed April 20, 2001 : Examiner M. Davis
For DNA ENCODING A NOVEL PROST 03 POLYPEPTIDE

Assistant Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

This is in response to the Restriction Requirement, mailed May 7, 2002, in which a one month period was set for response.

The Examiner has required restriction to one of the following groups:

- Group 1. Claims 1-7, 10-12, drawn to a polynucleotide encoding SEQ ID NO: 2, a polynucleotide of SEQ ID NO:1, and fragments thereof.
- Group 2. Claims 8, 38, drawn to a vector comprising a polynucleotide encoding SEQ ID NO: 2, a polynucleotide of SEQ ID NO: 1, and fragments thereof, and a vaccine comprising said vector for *in vivo* administration and immunizing a human against prostate cancer.

- Group 3. Claim 9, drawn to a host cell comprising a vector comprising a polynucleotide encoding SEQ ID NO: 2, a polynucleotide of SEQ ID NO: 1, and fragments thereof.
- Group 4. Claim 13, drawn to a method for producing a cell which expresses a polypeptide comprising engineering the cell with a vector comprising a polynucleotide encoding SEQ ID NO: 2, a polynucleotide of SEQ ID NO: 1, and fragments thereof.
- Group 5. Claims 14-15, 37, drawn to a polypeptide of SEQ ID NO: 2, fragments and variants thereof.
- Groups 6-10. Claims 16-27, drawn to an antibody or an immunoconjugate that specifically binds to 1) SEQ ID NO: 2 and SEQ ID NO: 23; 2) SEQ ID NO: 2 and SEQ ID NO: 26; 3) SEQ ID NO: 2 and SEQ ID NO: 25; 4) SEQ ID NO: 2 and SEQ ID NO: 21; and 5) SEQ ID NO: 2 and SEQ ID NO: 24.
- Groups 11-15. Claims 28-29, drawn to a method for selectively killing a cell or treating a disease-state associated with inappropriate expression of PROST 03, comprising administering an immunoconjugate that selectively binds to 1) SEQ ID NO: 2 and SEQ ID NO: 23; 2) SEQ ID NO: 2 and SEQ ID NO: 26; 3) SEQ ID NO: 2 and SEQ ID NO: 25; 4) SEQ ID NO: 2 and SEQ ID NO: 21; and 5) SEQ ID NO: 2 and SEQ ID NO: 24.
- Group 16. Claim 30, drawn to a method for treating a disease-state associated with inappropriate expression of PROST 03, comprising administering SEQ ID NO: 2.

- Group 17 Claim 31, drawn to a method for treating a disease-state associated with inappropriate expression of PROST 03, comprising administering a polynucleotide encoding SEQ ID NO: 2, or a portion thereof.
- Group 18-22 Claims 32-33, drawn to a method for diagnosing the presence of a polypeptide, using an antibody that specifically binds to 1) SEQ ID NO: 2 and SEQ ID NO: 23; 2) SEQ ID NO: 2 and SEQ ID NO: 26; 3) SEQ ID NO: 2 and SEQ ID NO: 25; 4) SEQ ID NO: 2 and SEQ ID NO: 21; and 5) SEQ ID NO: 2 and SEQ ID NO: 24.
- Group 23 Claim 34, drawn to a method for diagnosing the presence of a polynucleotide.
- Group 24-28 Claims 35-36, drawn to a method of diagnosing metastasis, using an antibody that specifically binds to 1) SEQ ID NO: 2 and SEQ ID NO: 23; 2) SEQ ID NO: 2 and SEQ ID NO: 26; 3) SEQ ID NO: 2 and SEQ ID NO: 25; 4) SEQ ID NO: 2 and SEQ ID NO: 21; and 5) SEQ ID NO: 2 and SEQ ID NO: 24.

Groups 11-15 (encompassing Claims 28-29) are provisionally elected with traverse. Within that grouping, Applicants elect Group 3: SEQ ID NO: 2 and SEQ ID NO: 25, and within that group, Applicants elect the single sequence species SEQ ID NO: 2 for examination.

Applicants, however, traverse the division of Claims 28 and 29 into five groupings, given they all have overlapping subject matter and the election of the single sequence species SEQ ID: 2 for examination insures that the Examiner will be including all of the five sequence fragments (from which the five groups derive) in any search (page 42 of the Specification indicates the position of each of sequences 21, 23, 24, 25 and 26

within SEQ ID NO: 2). Applicants therefore request that the Examiner reconsider the restriction of Claims 28 and 29 into five groups.

Applicants further point out that the description of Group 16, Claim 30, is incorrect, as it does not correctly describe the invention contained within that claim, which deals with the treatment of a disease state, comprising administering a therapeutically effective amount of a ribozyme. In view of the foregoing the Applicants respectfully request that Group 16 be rewritten as follows:

Group 16. Claim 30, drawn to a method for treating a disease-state associated with inappropriate expression of PROST 03, comprising administering a ribozyme.

Applicants respectfully request a written confirmation of these new groups by the Examiner.

Applicants reserve the right, under 35 U.S.C. 120, to pursue the non-elected subject matter of Groups 1-10 and 16-28 in separate divisional applications.

Respectfully submitted,



Wendy L. Washtien, Ph.D.
Agent for Applicant
Reg. No. 36,301

Berlex Biosciences
2600 Hilltop Drive
P.O. Box 4099
Richmond, CA 94806
Telephone: (510) 262-5411
Fax: (510) 262-7095
Date: June 4, 2002

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: **Assistant Commissioner for Patents, Washington, D.C. 20231** on June 4, 2002.

Carole J. Smith
Carole J. Smith

June 4, 2002
Date of Signature

1642
PATENT
Case: 51831AUSM1

RECEIVED

JUN 17 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of,
Lau et al.

Serial No. 09/838,785

Group Art Unit: 1642

Filed: April 20, 2001

Examiner: M. Davis

For: ***DNA Encoding a Novel Prost 03 Polypeptide***

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

TRANSMITTAL LETTER FOR RESTRICTION REQUIREMENT

Transmitted herewith for filing in the above-entitled patent application is the following.

1. Restriction Requirement
2. Return postcard

Petition for Extension of Time

This is being filed in the time allowed for response so no fee is due.

Deposit Fee Authorization

Any fee which may be required should be charged to Deposit Account No. 02-2117. This is not, however, an authorization to pay the issue fee. A duplicate of this document is enclosed.

Respectfully submitted,

Wendy L. Washtien

Wendy L. Washtien
Agent for Applicants
Registration No. 36,301

Date: June 4, 2002

Berlex Biosciences
2600 Hilltop Drive
P.O. Box 4099
Richmond, California 94804-0099
510.262-5411 Telephone
510.262-7095 Facsimile
wendy_washtien@berlex.com